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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,596	02/16/2001	Robert Casper	6208-003	4392
27383 7590 02/04/2009 CLIFFORD CHANCE US LLP 31 WEST 52ND STREET NEW YORK, NY 10019-6131				
EXAMINER				
KESACK, DANIEL				
ART UNIT		PAPER NUMBER		
3691				
MAIL DATE		DELIVERY MODE		
02/04/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/785,596

Applicant(s)

CASPER ET AL.

Examiner

Daniel Kesack

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 8, 10-16 and 21-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8, 10-16, 21-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 30, 2007 has been entered.

Status of Claims

2. Claims 1-5, 8, 10-16, 21-31 are currently pending. The rejections are as stated below.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 11-16, and 21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 11 and 21 recite a process comprising the method steps of forming files. Based on Supreme Court precedent, a proper process must be tied to another statutory class or transform underlying subject matter to a different state or thing (*In Re Bilski*; *Diamond v. Diehr*, 450 U.S. 175, 184 (1981) ; *Parker v. Flook*, 437 U.S. 584,588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876)). Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. Since the steps can be accomplished without the use of another statutory class, it is considered a non-statutory process.

While claim 11 recites "A method for organizing a computer-implemented account management system," the computer-implemented account management system does not appear in the body of the claim. The claim does not necessarily recite that the files are formed on the computer. In the alternative, the files could be formed in a filing cabinet, while use with the computer-implemented account management system is merely the intended purpose of the formation of the files. The claim should clearly recite that the method steps are connected to a statutory class.

Similarly, claim 21 recites "a method of using a computer for organizing an account management system..." The phrase could be interpreted as using a computer to print out pages which are used to form files. Such a use of a computer would be considered an extra solution activity, and does not make the invention patentable under 35 U.S.C. 101. Again, the claim should clearly recite that the method steps are connected to a statutory class.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-5, 8, 10-16, 21, 22, 30, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kalthoff, U.S. Patent No. 6,026,382, in view of Stein et al., U.S. Patent No. 5,978,779.

Claims 1, 11, 21, Kalthoff discloses a computer system comprising at least one programmable processor (figure 1, #12), and a data storage system (figure 1, #26), wherein said at least one programmable processor is operatively connected to said data storage system to receive data and instructions from said data storage system and to transmit data and instructions to said data storage system (column 2 lines 32-59), wherein said data storage system comprises:

- a party file having a plurality of party records (column 2, lines 63-66: tables of data storing a plurality of data objects, including party objects), each of said plurality of party records having party information related to a party (column 4 lines 1-8);

- an account file having a plurality of account records (column 2, lines 63-66: tables of data storing a plurality of data objects, including account objects), each of said plurality of account records having account information related to an account (column 4 lines 22-28), wherein each of said plurality of account records comprises a plurality of links to party records that specify roles played by the linked party for the account (column 5 lines 9-30: parties can be connected to accounts in a variety of relationships, including a customer, beneficiary, co-signor, or reference);

- a transaction file having a plurality of transaction records (column 2, lines 63-66: tables of data storing a plurality of data objects, including transaction), each of said

plurality of transaction records having transaction information related to an account (column 4 lines 34-40), and wherein each of said plurality of transaction records is linked to one of said plurality of account records (column 6 lines 40-55).

Kalthoff fails to teach a party record comprising party relationship data field indicating relationships between parties.

Stein discloses a system and method for structuring relationships between clients and financial service providers, where a party has a record with information related to a client, and the record includes various links to counterparties with whom the party has a relationship. The link is a field which indicates the party record of the counterparty, and also indicates the role and information about the counterparty. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Kalthoff to include linking party records to other parties because Kalthoff is concerned with freely linking parties, accounts, and transaction as any individual relationship dictates (figure 2). Kalthoff contemplates the situation where a party may be connected to a location, in that the party is the contact for that location, or a party may be connected to an organization, in that the party is the contact or representative for that organization. Taking into consideration the teachings of Stein, it would have been obvious to connect parties to other parties. If a party of Kalthoff is a business or organization, a possibility suggested by Kalthoff, it would be obvious to link this party to a second party (an individual) that is the contact or representative of the

organization. This type of tiered hierarchical party-party relationship is taught by Stein, and would improve the invention of Kalthoff in the same way, with predictable results.

While Kalthoff does not explicitly teach the information fields within the party, transaction, and account records, such information is regarded as non-functional descriptive material, and is not given weight in determining patentability over the prior art. The recitation that each party record has party information fields, and that the party information fields comprise data fields for legal name, address, jurisdiction of organization and legal form is not functional because the information fields are merely a collection of data. Kalthoff describes a database holding information about a party, and it would have been obvious to include any information that can describe that party. These recited fields impart no functionality when employed as a computer component. The fields merely hold data, and therefore are not given patentable weight. Similarly, the account information fields comprising a data field for account number, and the transaction information fields comprising data fields for account number, transaction number, transaction date, transaction type, instrument type, quantity and price, are not given patentable weight.

Claims 2-5, 8, 10, 22, Kalthoff and Stein do not explicitly teach that the party-party relationships define a principal role, an order placer role, a salesperson role, a booking company role, a parent-subsidiary relationship, or a guarantor-guarantee relationship between the parties. It would be obvious to include any number of fields within the profile of a party about which one would like to collect or store information.

The claimed relationships are all known in the art to be account descriptors, and information which a financial institution would desire to keep in the profile of a customer. Furthermore, since Kalthoff describes that a party can be more than just a client, but can also be a business or serve some other role, it would have been obvious that the party-party relationships could be used to define these other roles. The recitation that the data field describes a booking company, or an order placer, etc, is not a functional recitation because it is a mere arrangement of data which imparts no further functionality on the claimed invention.

Claims 12-16, 30, 31, the recitation of what the fields define is regarded as non-functional descriptive material, and is not given weight in determining patentability over the prior art. Claim 11 recites a method comprising forming files having records, said records having fields. The data held within these records does not affect the claimed method. The files are formed in the same way, regardless of the type of information held within the files. Therefore, Kalthoff and Stein teach the claimed invention as described above.

8. Claims 23, 24, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kalthoff and Stein, as applied above, and further in view of Bursey et al., U.S. Patent No. 7,356,497.

Kalthoff and Stein fail to teach searching existing records to determine whether a set of parties occurs in any of the existing accounts or whether the set is unique.

Bursey discloses a system for maintaining a brokerage accounts, wherein when client information is entered, the system determines whether the client is new, and then tests to see if there is any existing relationship in any existing accounts within the system. If the client is unique, a new account is established for the client (column 7 lines 22-64). Furthermore, the system determines whether a new operative agreement governs the transactions by allowing the user to select accounts which should be related to the flat fee brokerage account (column 7 lines 36-45), because it is obvious that a brokerage account would have an operating agreement between the client and the financial institution. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Kalthoff and Stein to include the searching for existing clients when adding a new client. The obvious benefit of this feature is to avoid duplicate entries in the account database. The system of Kalthoff and Stein would be improved in the same way by adding this feature, and the results are predictable.

Claims 23 and 24, It is further noted that the clause "when a new client transaction is being established and said transaction comprises a particular set of parties having defined role" is not given patentable weight in the claim. The claim is directed towards a system. The limitations on the system may define the structure of the system. The claim recites that the processor is structured to perform a search

function. The fact that the intended use of this function is to perform the search at a certain time of the day, or when certain conditions exist outside of the system does not further narrow the system itself. Since the prior art teaches the function, Examiner is of the opinion that the prior art teaches performing that function at any time, including the point in time recited in the claim language.

9. Claims 25, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kalthoff and Stein, as applied above, and further in view of McCoy et al., U.S. Patent No. 5,649,116.

Kalthoff and Stein fail to teach determining the risk exposure based on the total transaction amount between a group of related accounts.

McCoy discloses a system and method of approving transaction based on related accounts, where related parties are identified, all accounts which are have a related exposure limit are identified, a total transaction amount is determined and compared with a determined maximum risk exposure to decide whether a transaction should be authorized (column 6 line 55 – column 7 line 44). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Kalthoff and Stein to include this feature because McCoy discusses the benefits of determining total risk exposure over interrelated accounts, and the dangers of performing risk assessment on an account by account basis (column 1 lines 16-32).

Response to Arguments

10. Applicant's arguments with respect to claims 1, 11, and 21 have been considered but are moot in view of the new grounds of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Kesack whose telephone number is (571)272-5882. The examiner can normally be reached on M-F, 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully Submitted,

Daniel Kesack
January 29, 2009
/D. K./
Examiner, Art Unit 3691

/Hani M. Kazimi/
Primary Examiner, Art Unit 3691